UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,039	10/04/2000	Paul E. Jacobs	PA000373	5558

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EXAMINER
ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/679,039	JACOBS ET AL.
	Examiner	Art Unit
	Raquel Alvarez	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/18/2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40,111-113,126,127,136,137 and 146* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40,111-113,126,127,136,137 and 146* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　　a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)	4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6)☐ Other: .

DETAILED ACTION

1.   This office action is in response to communication filed on 8/18/2003. Applicant

elected without traverse Group I consisting of claims 1-40, 111-113 , 126-127, 136-137

and 146.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,*
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

2.   Claims 1-40, 111-113 , 126-127, 136-137 and 146 are provisionally rejected

under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 1-18 and 51-53 of copending Application No.09/668,553.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because the instant application further recites transmitting ad-statistical data.

Calculating and transmitting statistical data it is old and well known in business in order

to calculate and transmit statistical data in order to make educated assumptions and

statements on a particular subject. It would have been obvious to a person of ordinary

skill in the art at the time of Applicant's invention to have included transmitting ad-

statistical data in order to achieve the above mentioned advantage.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

3.   Claims 14-15 Claim are rejected under 35 U.S.C. 112, second paragraph.

Claims 14 and 15 depend from claim 10 which recites that the client information

includes demographic data but claims 14-15 don't further limit the demographic data

claimed in claim 10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-6, 9, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claims 1-6, 9, 12-13, 16, 18-20, 26, 32, 35, 111, 112, 113 Marsh

teaches software for use on a client device that is configured for communications with at

least one remote source of advertisements via a communications network (Abstract).

An advertisement download function that downloads advertisements from at least one

remote source, during one or more advertisements download sessions (see figure 4,

item 601); an advertisement store function that stores the download advertisements on

a storage medium associated with the client device (col. 14, lines 1-10); an

advertisement display function that effects display of at least selected ones of the stored

advertisements on a display associated with the client device (Figure 6, 702); an audit

function that compiles as-related statistical data relating to the downloaded

advertisements, wherein the ad-related statistical data includes display event-related

data regarding advertisements that were displayed during a prescribed audit interval

(col. 14, lines 66-, col. 15, lines 1-7); an audit data transmit function that transmits the

ad-related statistical data to a prescribed server system (Figure 8 and col. 15, lines 10-

20).

Marsh teaches sending the statistical data to the server (Figure 8 and col. 14,

lines 66-, col. 15, lines 1-20). Marsh does not specifically teach sending the data only in

response to a user's grant permission to do so. Montague teaches delivering vendor-

supplied information to a purchaser while the purchaser authorizing transmission of

various data to a vendor server or a third party server (col. 9, lines 20-24). It would

have been obvious to a person of ordinary skill in the art at the time of Applicant's

invention to have included in the system of Marsh the teaching of Montague of sending

the data only in response to a user's grant permission to do so because such a

modification would allow the users to have controlled of the data that is transmitted.

With respect to claim 7, Marsh further teaches under a client policy transmitting a statistical sampling of a population of client devices, at prescribed times (col. 3, lines 12-27 and col. 7, lines 7-24).

Claim 8 further recites transmitting to random ones of population of client devices at prescribed times. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the audit at random times in order to obtain the above mentioned advantage.

With respect to claims 10-11, 14-15, 17, 29 Marsh further teaches that the client information includes user demographic data and transmitting the information to the prescribed server system (col. 3, lines 12-27).

With respect to claims 21, 27, 30, 33 and 36, Marsh further teaches that the advertisement distribution server system is managed by a producer of the software (col. 3, lines 12-56).

With respect to claims 22, 28, 31, 34 and 37, Marsh further teaches that the advertisement distribution server system is managed by a distributor of the software (col. 3, lines 12-56).

With respect to claim 23, Marsh further teaches that the communication network is the Internet (Figure 8, 107).

With respect to claim 24, Marsh further teaches that the software is e-mail software (see Figure 8).

Claims 25, 38-40 further recite that the client information includes the distributor identifier for transmitting the client information to the prescribed server system. Marsh teaches transmitting the client information to a prescribed server system (Figure 8 and col. 15, lines 10-20 and col. 14, lines 66-, col. 15, lines 1-20). Marsh does not specifically teach including the distributor identifier. Official notice is taken that it is old and well known to provide identity information such as a name or number in order to point out individuality between the subjects. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the distributor identifier in order to obtain the above mentioned advantage.

With respect to claim 126, Marsh further teaches that advertisement display function effects display when the client device is offline (col. 6, lines 63-, col. 7, lines 1).

With respect to claim 127, Marsh further teaches that the advertisement display function effects display while the user is composing/reading e-mail messages (col. 7, lines 1-6).

Claims 136-137 further recite that the audit data is transmitted at activated random times. Marsh teaches transmitting audit data (col. 14, lines 66-, col. 15, lines 1-7). Marsh does not specifically teach transmitting the audit data at random times. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting the audit at random times in order to obtain the above mentioned advantage.
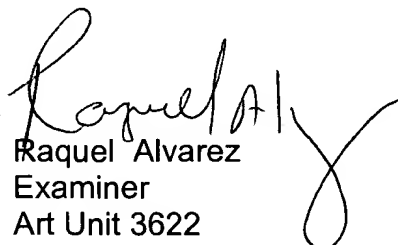
With respect to claim 146, Marsh further teaches clickthrough data regarding each advertisement that was clicked on by the user during the prescribed audit interval (col. 15, lines 14-20).

Point of contact

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
10/14/03